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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David Shen

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BRINKS HOFER GILSON & LIONE / YAHOO! OVERTURE

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/633,168	Applicant(s) SHEN ET AL.	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 3-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In each independent claim 1 and 20, the "enjoyability", "relevance" and "impact" ratings are indefinite. The ratings are based on variable (relative, subjective) terms and scales. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention. And, while three scales are claimed, the lack of objective definition leaves it indefinite as to what the significance of each scale is. The scales are defined in terms of different words, but there is no substantive basis to differentiate any scale from any other. (MPEP § 2173.05(B))

Applicability of 35 USC 112, 6th Paragraph

3. It appears the applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph in claims 20-36 and 38 by using "means-plus-function" language, such as "means for collecting" (claim 20 line 3). Also see p. 11, top para. of the arguments filed 13 February 2009. In order to successfully invoke the sixth paragraph, a three-prong test must be met (MPEP § 2181.I): (1) the claim limitations must use the phrase "means for" or "step for; (2) the "means for" or "step for" must be modified by functional language; and (3) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function. The above claims pass the three prong test, so 35 U.S.C 112, 6th paragraph has been successfully invoked. The Examiner will consider the means to perform the claimed functions as the means disclosed, specifically in para. [0096] *et seq.* of the published application (US 20040204983A1), and equivalents thereof. This constitutes the broadest reasonable interpretation of the claims (MPEP § 2181.I).

Claim Rejections - 35 USC § 102 and 35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-9, 11, 14, 16-28, 30 and 34-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al. (US 20020042738A1, hereafter "Srinivasan").
7. Srinivasan teaches (independent claims 1 and 20) a computer-readable medium (*database 275*, Fig. 2 and para. [0067]) containing an executable method of determining, through the use of at least one processor, the performance of an ad, comprising:

collecting, with the at least one processor, a plurality of input data points (*different formats of the same advertisement and statistics are kept on the audience response to each format*, para. [0029]; *information derived from user logins, cookies ...*, para. [0049]; and *item(s) purchased, ad clicked on*, item 305 in Fig. 3 and para. [0072]);

collecting, with the at least one processor, a plurality of outcome data points (*output from the Server Module 260*, para. [0059]); and

calculating, with the at least one processor, performance scores (*optimal values of key market decision variables ...*, para. [0025]; and *the click-through rate and the buy-rate*, para

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[0086]; and the example given at para. [011124]-[0118] inclusive¹) based upon the input data points and outcome data points;

wherein the input data points include data points selected from the group consisting of:

data points about an advertisement description (*the five ads*, para. [0114]),

data points about a creative description (*different formats of the same advertisement*, para. [0029]), and

data points about a user description (*information derived from user logins, cookies ...*, para. [0049]).

8. Srinivasan does not explicitly teach

wherein the outcome data points include data points selected from the group consisting of:

data points identifying an enjoyability rating reflecting how enjoyable or annoying the advertisement was to the user, wherein the enjoyability rating corresponds to a rating on an enjoyability and annoyance scale;

data points identifying a relevance rating reflecting the relevance of the subject matter of the advertisement to the user, wherein the relevance rating corresponds to a rating on a degree of relevance scale; and

data points identifying an impact rating reflecting the impact of an advertisement on the user's opinion of the advertiser or media owner, wherein the impact rating corresponds to a rating on an impact scale.

However, since the structure recited in the reference is substantially identical to that of the claims, these claimed properties or functions are presumed to be inherent (MPEP § 2112.01). As evidence tending to show inherency, it is noted that the performance scores *click-through rate* and *buy-rate* (para. [0023], [0086] and [0087]) calculated from both the input data points and the output data points read on the claimed "enjoyability rating", "relevance rating" and "impact rating". A user would not click through an ad link if they found the ad to be annoying (i.e., not enjoyable). And a user would not buy the associated product

¹ In Table 1 on p. 7, there is a typo in the last *Posterior Distribution* value: It must be 0.167, not 0.271. Then all five values sum to 1 and are all proportional to *Click Rate*.

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if they had not found the ad to be relevant and did not trust or otherwise had a high opinion of the product's advertiser.

9. Srinivasan also teaches at the citations given above claims 5-9, 11, 14, 17-19, 21-28, 30 and 34-38.

10. Srinivasan also teaches: claims 3, 4, 21 and 22 (para. [0058], where *an employee* reads on "an Evaluator").

11. Claims 10, 12, 13, 15, 16, 29 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al. (US 20020042738A1, hereafter "Srinivasan"). Srinivasan does not teach (claims 10 and 29) a pop-up window and (claims 12, 13, 15, 16 and 31-33) soliciting comments that are analyzed for key words. However, the reference does teach determining the *audience response* (para. [0029]) and that *surveys* of the audience are common (para. [0022]). Official notice is taken (MPEP § 2144.03) that pop-up windows were a common means of presenting surveys at the time of the instant invention. Asking for comments in the surveys was also common, and key-word analysis would have been an obvious mechanical efficiency in analyzing these comments.

12. Official notice of this common knowledge or fact well known in the art was taken in the Office action mailed 27 June 2008. Since applicant failed to traverse the examiner's assertion, it is taken to be admitted prior art (MPEP 2144.03.C).

Response to Arguments

13. Applicant argues filed with an amendment on 24 June 2009 have been fully considered in the revised rejection. The traverse of official notice was addressed in the office action mailed on 5 January 2009 and is no longer seasonable (MPEP § 715.09).

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of

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the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
17. The examiner's supervisor, Robert Weinhardt, can be reached on 571-272-6633.
18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
19. **AFTER FINAL INTERVIEW PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence in an interview request (form PTOL-413A) that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
20. Applicant may have after final arguments considered and amendments entered by filing an RCE.

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21. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).

23 October 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688